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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,808	05/05/2005	Toyoaki Kurihara	271534US0PCT	4297
22850	7590	09/30/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
MULLS, JEFFREY C				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/30/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

### Office Action Summary

**Application No.**

10/533,808

**Applicant(s)**

KURIHARA ET AL.

**Examiner**

Jeffrey C. Mullis

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 5, 7, 8 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7, 8 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 2-5-08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Example 2 does not recite a temperature of "about 80 degrees" and this limitation is therefore new matter.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear if the temperature referred to pertains to the water temperature or temperature of the polymer since claim 13 can be interpreted both ways.

Claims 1, 2, 4, 5, 7, 8, and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Such et al. (US 2006/0223936).

Patentees disclose a process in which a macro RAFT agent containing polyacrylate blocks is polymerized with methacrylate monomers in a process in which the RAFT blocks are bound inherently to blocks produced from the added monomers (paragraphs 33 and 132). Note for instance Example 1b where an acrylate ester containing RAFT agent is polymerized with methylmethacrylate monomer to form 40nm particles and note numerous similar examples which disclose similar particle sizes. Note that the particulate form may be maintained on drying at paragraph 113. Patentees examples in which acrylate ester-block-methacrylate containing ester block copolymers

would reasonably appear to inherently have applicants characteristics as all features of the claimed invention are present although applicants characteristics are not explicitly disclosed. With re to applicants product claims reciting molding, these claims encompass for instance molding processes in which a film is molded to a surface as a coating and as the patent discloses coatings, the products of the publication and claims reasonably appear to be the same. With regard to claim 13, the instant claims are drawn to a product not a process and it is not clear why the temperature of cutting (which is furthermore unclear) should effect the resulting particulates.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al., 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983); In re Brown, 173 USPQ 685 (CCPA 1972) and In re Thorpe, 227 USPQ 964 (CAFC 1985) in this regard.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 1, 2, 4, 5, 7, 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiumi et al. (US 6,329,480) in view of Hikasa et al. (US 5,308,699) in view of Sumitomo Chemical (Derwent Abstract ACC-NO: 1997-113985) or Nagasawa (CAPLUS abstract of JP 52148956).

Uchiumi et al. in Examples 14 and 15 disclose diblock copolymers having an acrylate ester block and a methacrylate ester block as required by the claims with molecular weights within the range of those disclosed by applicants and as viscosity is associated with melt or solution states, the lack of powder form is immaterial to the question of whether or not applicants characteristics are inherent in the patent. Due to the similarity of applicants and patentees structures, applicants and patentees characteristics reasonably appear to be the same. Note columns 12 and 13 where it is disclosed that acrylate ester block-methacrylate ester-block-acrylate ester triblock copolymers can be produced. Note the paragraph bridging columns 19 and 20 for use of the materials as molding resins. While particular molding processes are not

disclosed, claims 8 and 10-12 are drawn to a product, not a process. Applicants may argue that the materials of patentees are not powders which is true. However, it appears that applicants view their claims as encompassing not only actual powders but molded powders (as evidenced by the dependent claims which presumably take all the limitations of the independent claims, a form in which no powder character remains.

Uchiyumi et al. in Examples 14 and 15 disclose diblock copolymers having an acrylate ester block and a methacrylate ester block as required by the claims with molecular weights within the range of those disclosed by applicants and as viscosity is associated with melt or solution states, the lack of powder form is immaterial to the question of whether or not applicants characteristics are inherent in the patent. Due to the similarity of applicants and patentees structures, applicants and patentees characteristics reasonably appear to be the same. Note columns 12 and 13 where it is disclosed that acrylate ester block-methacrylate ester-block-acrylate ester triblock copolymers can be produced. Note the paragraph bridging columns 19 and 20 for use of the materials as molding resins. While particular molding processes are not disclosed, claims 8 and 10-12 are drawn to a product, not a process.

Hikasa et al. discloses a thermoplastic elastomer in powder form with characteristics encompassing those of applicants (column 4, lines 29-35) in which a mold can be sprayed for forming complicated shapes without pinholes and having good appearance(column 3, lines 29-40 and column 4, lines 29-35, column 5, lines 1-3).

Sumitomo Chemical (Derwent Abstract ACC-NO: 1997-113985) discloses that underwater cutting processes produces particulate materials with less undesirable low fines while Nagasawa discloses that improved flowability results from underwater cutting processes.

The primary reference does not disclose powder form or slush molding. However, it would have been obvious to a practitioner having an ordinary skill in the art to use the material of the primary reference in powder form having applicants characteristics and to use slush molding motivated by the disclosure of the primary reference that molded objects should be formed from the composition and by the secondary references disclosure that formation of a powder with applicants characteristics facilitates slush molding which results in molded objects with particularly good appearance and can be used even when making complicated shapes absent any showing of surprising or unexpected results.

While use of underwater cutting processes are not disclosed by the primary reference, use of such as taught by Sumitomo Chemical (Derwent Abstract ACC-NO: 1997-113985) and Nagasawa would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of reduced fines and better flowability absent any showing of surprising or unexpected results.

With regard to claim 13, the instant claims are drawn to a product not a process and it is not clear why the temperature of cutting (which is furthermore unclear) should effect the resulting particulates.

The declaration under 37 CFR 1.132 filed 2-5-08 is insufficient to overcome the rejection of claims 1, 2, 4, 5, 7, 8 and 13 based upon Such et al. as set forth in the last Office action because: Such et al. do not use the comminuting process in applicants comparative example.

The declaration under 37 CFR 1.132 filed 2-5-08 is insufficient to overcome the rejection of claims 1, 2, 4, 5, 7, 8 and 13 based upon Such et al. as set forth in the last Office action because: It appears to have been known in the art at the time of the invention that pulverization leads to poorer flowability as evidenced by Tomihashi (US 6,376,647) at column 1, lines 50-60.

Applicant's arguments filed 1-2-08 have been fully considered but they are not persuasive. With regard to Such, the defects in applicants declaration are set out above. Applicants are claiming a product not a process and it is therefore immaterial that Such does not disclose an underwater cutting process.

With regard to Uchiumi, as set out above it appears that it was known in the art at the time of the invention that pulverization lead to poorer flow.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis  
M-F, 9-5 pm at telephone number 571 272 1075.

Jeffrey C. Mullis  
Primary Examiner  
Art Unit 1796

/Jeffrey C. Mullis/  
Primary Examiner, Art Unit 1796